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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,427	11/22/2000	David Charles C. Hinde	PM271885	5030

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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 11/30/2001

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/623,427

Applicant(s)
Hinde et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 and 35-45 is/are rejected.
- 7) ☒ Claim(s) 33 and 34 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 1 20) ☐ Other:

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1. Claims 33 and 34 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

2. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 provides for the use of water soluble packaging, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 28 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The 5 to 35 weight percent range fails to further limit claim 2.

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4. Claims 15-17 and 38-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, it is unclear how “added” is to further limit or define the chain extending compound.

Secondly, it is questioned if the dependency of claim 38 is correct, because claim 37 appears to specify that water is the sole extender, in one embodiment.

Thirdly, within line 2 of claim 39, it is questioned why there are two commas following “alicyclic”.

5. Claims 1-32 and 35-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 1, 18, 30, 41, and 45, it is unclear if the acid group percent value is to be weight or mole percent. Also, the basis should be clarified.

6. Claims 19-21 and 42-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Markusch groups of claims 19, 20, 42, and 43 are improper; the species should be referred to in the alternative.

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7. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of the word, "type", so extends the scope of the terms that they are rendered indefinite. There is no way of determining what structures fall within the "types".

8. Claims 31, 32, and 37-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language of claim 31 fails to further limit claim 30, because the language fails to agree with the process step sequence within claim 30. Claim 30 requires the polyurethane polymer to be produced prior to forming the aqueous solution.

Additionally, It is unclear that the language of claim 37 further limits claim 30, because claim 37 allows for the production of the polyurethane after introducing the prepolymer into the water.

9. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within line 2; step I should be referred to.

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10. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if “as well as” is simply to be interpreted as “and”, and it is unclear what purpose is served by reciting all temperatures.

11. Claims 2, 3, 9-11, 13-21, 23, 26, 35, and 37-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All language denoted by “preferably”, “more preferably”, and “especially” renders the claims indefinite, because it is unclear if or to what extent the narrow language is to modify the broad language within the same claim.

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 1-32 and 35-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomaides et al. ('840) in view of Markusch et al. ('852).

Thomaides et al. disclose the production of water soluble films from polyurethane aqueous dispersions. The polyurethane dispersions are produced by incorporating potential ionic hydrophilic groups into the polyurethane and neutralizing them by reaction with a base to yield an ionic group containing polyurethane which readily disperses in water. Thomaides et al. further provide important guidance at column 2, lines 55+, wherein patentees state that difunctional reactants must be used in order to prevent crosslinking.

14. Though Thomaides et al. disclose the use of ethylene oxide group containing reactants, patentees fail to describe that the use of such reactants will contribute nonionic hydrophilic groups to the polyurethane. Furthermore, Thomaides et al. fail to disclose the use of a prepolymer process to produce the polyurethane aqueous dispersion. However, the use of the ethylene oxide groups to contribute hydrophilic and water dispersible characteristics to polyurethanes and the use of prepolymer processes to produce them was known at the time of invention. This position is supported by the detailed description of Markusch et al.

15. Therefore, the position is taken that one of ordinary skill in the art seeking a water soluble polyurethane would have been motivated to follow the teachings of the primary reference and further to incorporate known techniques for producing enhanced dispersible polyurethanes, as

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taught by Markusch et al., into the teachings of the primary reference, so as to arrive at the instant invention.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent/ng

November 16, 2001